

12-94-02

RCE/1660

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#17  
JLP  
12/18/02  
RECEIVED**REQUEST FOR CONTINUED EXAMINATION (RCE)  
TRANSMITTAL**

Address to:

**Commissioner for Patents  
Box RCE  
Washington, D.C. 20231**

Attorney Docket No. 02-731-C  
Application No. 09/674,815  
Filing Date: December 7, 2000  
First Named Inventor: Akira Aomatsu  
Group Art Unit: 1614  
Examiner Name: Brian Yong S. Kwon

**This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.****1. Submission required under 37 C.F.R. § 1.114**

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on July 30, 2002.
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- iii. ☐ Other
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other

**2. Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17 (i) required)
- b. ☒ Other : Associate Power of Attorney

APPLICATION FEES		
BASIC FEE		\$ 740.00
<input checked="" type="checkbox"/> Extension of Time fee	920.00+\$	\$ 920.00
<input type="checkbox"/> Other	+\$	\$
Total of above calculations =		\$
Reduction by 50% for filing by small entity =		\$( )
TOTAL =		\$ 1660.00

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**REQUEST TRANSMITTAL**

Attorney Docket No. 02-731-C

3. ☐ Please charge my Deposit Account No. 13-2490 in the amount of \$.
4. ☒ Two checks in the amount of \$740.00 and \$920.00 is enclosed.
5. The Commissioner is hereby authorized to credit overpayments or charge any additional fees of the following types to Deposit Account No. 13-2490:
- a. ☒ Fees required under 37 CFR 1.16.
  - b. ☒ Fees required under 37 CFR 1.17.
  - c. ☒ Fees required under 37 CFR 1.18.
6. The Commissioner is hereby generally authorized under 37 CFR 1.136(a)(3) to treat any future reply in this or any related application filed pursuant to 37 CFR 1.53 requiring an extension of time as incorporating a request therefor, and the Commissioner is hereby specifically authorized to charge Deposit Account No. 13-2490 for any fee that may be due in connection with such a request for an extension of time.

**7. CERTIFICATE OF MAILING OR TRANSMISSION**

☐ I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office at 703-308-4556, or being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to :Commissioner for Patents, Box RCE, Washington, DC 20231 on the date indicated below.

☒ I hereby certify that, under 37 CFR § 1.10, I directed that the correspondence identified above be deposited with the United States Postal Service as "Express Mail Post Office to Addressee," addressed to the Commissioner for Patents, Box RCE, Washington, DC 20231, on the date indicated below. Express Mail No. EL604657831US.

**8. USPTO CUSTOMER NUMBER****20306**

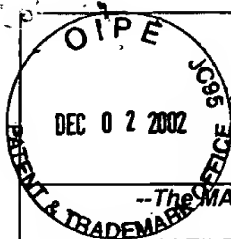
PATENT TRADEMARK OFFICE

**McDonnell Boehnen Hulbert & Berghoff****9. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name	Stephen H. Docter
Reg. No.	44,659
Signature	<i>Stephen H. Docter</i>
Date	December 2, 2002

RCE (Rev. 11/27/00)

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# Advisory Action

Application No.

09/674,815

Applicant(s)

AOMATSU, AKIRA

Examiner

Brian S Kwon

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-9 and 18-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

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ZOHREH FAY  
PRIMARY EXAMINER  
GROUP 1200

*submit for*

Continuation of 2. NOTE:

Applicants proposed amendment raises the issue of new matter. Applicants recitation of "provided that when the 4-amino-3-substituted-butanoic acid derivative is gabapentin and the alpha-amino acid is a methyl-aspartic acid, the methyl aspartic acid is not methyl-D-aspartic acid" in claim 1 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It appears that applicants were never contemplated of using specifically "methyl-aspartic acid, the methyl aspartic acid is not methyl-D-aspartic acid" as a stabilizer when the 4-amino-3-substituted-butanoic acid derivative is gabapentin. Therefore, the proposed amendment will not be entered.

In addition, the proposed amendment in claim 24 fails to further limit the subject matter of a previous claim. The scope of the claim 24 appears to be broader than parent claim 1 by the inclusion of glycine and 4-amino-3-substituted-butanoic acid derivative combination when R2 is a phenyl or naphthyl group which is mono, di, or tri-substituted with a halogen atom. Such inconsistency make the claim 24 indefinite of what is the claimed subject matter.